

REMARKS

By the present amendment, Applicants have amended claims 26-41, to more appropriately define the invention, and added new claims 42-43 to protect additional aspects of the invention. Claims 26-43 are currently pending.

In the Final Office Action, the Examiner rejected claims 26-28, 32-33, and 37-41 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,665,951 (hereinafter, "Newman") and rejected claims 29-31 and 34-36 under 35 U.S.C. § 103(a) as being unpatentable over Newman. These rejections are respectfully traversed for the following reasons.

REJECTION UNDER 35 U.S.C. § 102(b)

Anticipation under 35 U.S.C. § 102 requires that each and every claim element is found, either expressly or inherently described, in a single prior art reference.

Applicants respectfully traverse the rejection of claims 26-28, 32-33, and 37-41 as being anticipated by Newman. Generally, Newman describes a manner in which a potential customer may purchase articles of clothing from a store, while having a storage medium that allows the customer to access information about the customer's existing wardrobe. Specifically, the storage medium may be a smart card or floppy disk and contains information of the potential customer's clothes, such as the color, size, etc. The customer may access this information at a kiosk provided by the store, so that the customer may make a determination on whether the existing wardrobe is compatible with clothes offered by the store. Based on that determination, the customer may decide to purchase new clothes from the store. Additionally, if the customer does

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decide to purchase new clothes from the store, that information may be updated in the customer's storage medium.

However, Newman only discloses displaying a customer's existing information (i.e., the customer's wardrobe) and storing newly purchased clothing information into the customer's storage medium. Therefore, Newman does not disclose "an electronic coupon bar code," as claimed in claims 26-28, 32-33, and 37-40.

Furthermore, with respect to claims 26, 32, and 37, Newman does not disclose at least an "information processing terminal" that:

"reads, using its bar code reader, the electronic coupon bar code contained in the image data displayed on the display means of the portable terminal, recognizes the electronic coupon content according to the electronic coupon bar code that has been read, performs the necessary processing to provide a service. . . ."

Similarly, Newman does not disclose each and every element of claims 39 and 40 which contain similar claim elements as claims 26, 32, 37.

With respect to claim 41, Newman does not disclose, either expressly or inherently, all the claim elements, including, at least, "a second personal database for registering the user's purchase history information sent from the information processing terminal." (See claim 41).

In addition, Newman does not disclose, either expressly or inherently, the subject matter of new claims 42 and 43, including, at least, a "product that suits the user's presumed tastes." (See claims 42 and 43).

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 26, 32, 37, 39, 40, and 41. Applicants also respectfully request the

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Examiner to withdraw the rejection to claims 27, 28, 33, and 38, based, at least, on their respective dependency upon allowable independent claims 26, 32, or 37.

Based upon the above reasons, Applicants respectfully request the allowance of claims 26-28, 32-33, and 37-41, as well as new claims 42 and 43.

REJECTION UNDER 35 U.S.C. § 103(a)

To establish a prima facie case of obviousness, each of three requirements must be met. First, the references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8th ed. 2001)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See *id.* Third, a reasonable expectation of success must exist. See *id.* Moreover, each of the these requirements must "be found in the prior art, and not based on applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001)).

Applicants respectfully traverse the rejection of claims 29-31 and 34-36 as being obvious in view of Newman. As noted above, Newman describes a manner in which a potential customer may purchase articles of clothing from a store, while having a storage medium that allows the customer to access information about the customer's existing wardrobe. It provides a teaching of allowing a customer to access the customer's wardrobe without bringing the clothes to the store or relying on memory to determine if clothes within the existing wardrobe are compatible with clothes offered by the store. (See Newman, col. 1, ll. 34-36). Therefore, Newman does not teach nor suggest each and every element of claims 29-31 and 34-36, including, at least, an

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“electronic coupon bar code.” In addition, Newman does not teach or suggest a server specifying the “electronic coupon content . . . on the basis of the user’s purchase history in the personal database,” as claimed in claims 29, 30, 34, and 35 and the “discount of the price” as claimed in claims 31 and 36.

In addition, on pages 5-6 the Examiner admits that Newman fails to teach a method “to provide a better service rate/price or discount with regard to products having a high purchase frequency or most sold/purchased item by the user, [and] method regarding products for which the seller want to increase or decrease the price based on the user’s purchased history.” The Examiner then simply concludes that an artisan of ordinary skill would employ into the teaching of Newman “a method to provide a better service rate/price or discount with regard to products having a high purchase frequency or most sold/purchased item by the user, [and a] method regarding products for which the seller want to increase or decrease the price based on the user’s purchased history,” presumably to render claims 29-31 and 34-36 obvious. (See Office Action, pg. 5). However, the Examiner has provided no basis nor any motivation to employ those features into Newman. In fact, it appears the Examiner is simply using Applicants’ application as improper hindsight to combine elements in order to justify an obviousness rejection. This is improper. (M.P.E.P. § 2143 (8th ed. 2001)).

Furthermore, Newman does not teach nor suggest the subject matter of new claims 42 and 43, including, at least, a “product that suits the user’s presumed tastes.” (See claims 42 and 43).

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Accordingly, Applicants respectfully request the Examiner to withdraw the rejection to claims 29-31 and 34-36 and based upon the reasons above, allow claims 29-31, 34-36, as well as new claims 42 and 43.

CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 26-43 in condition for allowance. Applicants submit that the proposed amendments of claims 26-41 and the addition of claims 42-43 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this

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Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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